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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR.	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/646,167	09/14/2000	Anton Enterrottacher	P00.0637	5982

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EXAMINER

MEISLAHN, DOUGLAS J

ART UNIT	PAPER NUMBER
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2137

DATE MAILED: 02/27/2004

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/646,167

Applicant(s)

ENTERROTTACHER ET AL.

Examiner

Douglas J. Meislahn

Art Unit

2137

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4-7 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 4-7 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Priority

1. It is noted that this application appears to claim subject matter disclosed in prior Application No. PCT/DE99/00415, filed 16 February 1999. A reference to the prior application must be inserted as the first sentence of the specification of this application or in an application data sheet (37 CFR 1.76), if applicant intends to rely on the filing date of the prior application under 35 U.S.C. 119(e) or 120. See 37 CFR 1.78(a). For benefit claims under 35 U.S.C. 120, the reference must include the relationship (i.e., continuation, divisional, or continuation-in-part) of all nonprovisional applications. Also, the current status of all nonprovisional parent applications referenced should be included.

If the application is a utility or plant application filed under 35 U.S.C. 111(a) on or after November 29, 2000, the specific reference to the prior application must be submitted during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application. If the application is a utility or plant application which entered the national stage from an international application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the specific reference must be submitted during the pendency of the application and within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) or sixteen months from the filing date of the prior application. See 37 CFR 1.78(a)(2)(ii) and (a)(5)(ii). This time period is not extendable and a failure to submit the reference required by 35 U.S.C.

119(e) and/or 120, where applicable, within this time period is considered a waiver of any benefit of such prior application(s) under 35 U.S.C. 119(e), 120, 121 and 365(c). A priority claim filed after the required time period may be accepted if it is accompanied by a grantable petition to accept an unintentionally delayed claim for priority under 35 U.S.C. 119(e), 120, 121 and 365(c). The petition must be accompanied by (1) the reference required by 35 U.S.C. 120 or 119(e) and 37 CFR 1.78(a)(2) or (a)(5) to the prior application (unless previously submitted), (2) a surcharge under 37 CFR 1.17(t), and (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

Information Disclosure Statement

2. A set of references is included in the file, but there is no 1449 indicating that they are to be considered.

Oath/Declaration

3. Receipt is acknowledged of papers filed under 35 U.S.C. 119 (a)-(d) based on a PCT application filed on 16 February 1999. Applicant has not complied with the requirements of 37 CFR 1.63(c), since the oath, declaration or application data sheet does not acknowledge the filing of any foreign application. A new oath, declaration or application data sheet is required in the body of which the present application should be identified by application number and filing date.

Claim Objections

4. Claim 7 is objected to because of the following informalities: the middle mathematical equation in the middle of claim 7 has an unmatched number of open and close parentheses. Appropriate correction is required. The application has been examined as though a second open parenthesis was inserted between the E and Z. This same error occurs in the preliminary amendment on page 2 at line 27.

Notes

5. Before beginning the analysis of the claims, a description of terminology is in order.

6. Applicant describes a certificate as corresponding “to the public key p, to the name and further details of a subscriber X” at the top of page 3. In lines 15-17 of the same page, applicant says that a certificate “contains” a public key. While applicant’s terminology is acceptable, it is also atypical. A certificate is generally thought of as a public key signed by a trusted figure, as described by Bruce Schneier on pages 185-187 of *Applied Cryptography*. Applicant’s signature of the certificate corresponds with the conceptualization of certificates presented by Schneier.

7. Applicant refers to “signature” keys. The specification and claim 4 make clear that these are the same as public keys. The examiner’s initial assumption was that a “signature” key was identical to a private key, although there are no references supporting this assumption. The examiner strongly recommends changing the wording from “signature” to “public”.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davis (5539828) in view of Rune (5850444).

In figure 6, Davis describes a system of assigning a key pair and certificate to an agent. The agent reads on applicant's device. As shown by the description of step 155, a unique public/private key pair and a certificate are stored in the agent. The public key of the key pair and identification information innate to the agent anticipate applicant's device-specific certificate. The certificate is unique to the manufacturer, as disclosed in step 145. As such, its inclusion in the agent anticipates the second clause of claim 1. The third clause is anticipated by elements 125 and 130, which compare a new public key with a list; were there to be an unlimited number of agents, the comparison would never end. As shown in step 210 of figure 7, the certificate is verified with the manufacturer's public key. Davis does not say that each agent is imbued with a group-specific public key. In lines 41-46 of column 6, Rune describes broadcasting a public key of a central authority to a plurality of terminals. By removing the step of requesting this public key, the terminals are able to more quickly perform transactions. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention

was made to assign each agent with a group-specific public key as taught by Rune in order to improve the speed of transactions.

Claim 5 is rendered obvious because the group-specific signature (Davis' certificate) is stored in the agent during its manufacture. This would make the concurrent storage of the group-specific public key obvious. Figure 6 is apparently the first initialization of the agent. The limitations of claim 7 are rendered obvious by step 210 of figure 7.

10. Claim 6 rejected under 35 U.S.C. 103(a) as being unpatentable over Davis in view of Rune as applied to claim 4 above.

Davis and Rune present a system that imparts a public/private key pair, certificate, public key associated with the certificate on an agent. They do not say that the storage of the certificate and associated public key are presaged by a comparison of the agent with a list of approved agents. Official notice is taken that it is old and well-known to allow access to agents to groups and to vet the agents against lists of approved agents prior to such an admission. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to let the agent described by Davis into a group and to compare the agent to a list of approved agents in order to insure that the agent was allowed to join the group.

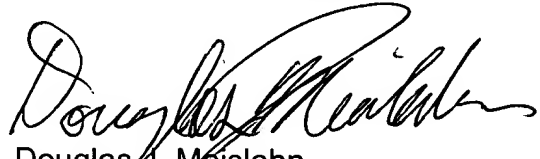
Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Cassagnol et al. (6438666), Walker et al. (6289453, 6282648, 5923763, 5825751), and Davis (5796840).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Douglas J. Meislahn whose telephone number is (703) 305-1338. The examiner can normally be reached on between 9 AM and 6 PM, Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory A. Morse can be reached on (703) 308-4789. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Douglas J. Meislahn
Examiner
Art Unit 2137

DJM